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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,163	02/27/2002	David Robin Tomlinson	24161196.2	8034

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BAKER & MCKENZIE
PATENT DEPARTMENT
2001 ROSS AVENUE
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DALLAS, TX 75201

EXAMINER

NALVEN, ANDREW L

ART UNIT PAPER NUMBER

2134

DATE MAILED: 09/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/085,163

Applicant(s)

TOMLINSON, DAVID ROBIN

Examiner

Andrew L. Nalven

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12-17 is/are rejected.
- 7) ☒ Claim(s) 11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/4/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-17 are pending.

Drawings

1. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claim 1 is rejected under 35 U.S.C. 101 because the disclosed invention is inoperative and therefore lacks utility. The cited claim is directed towards a hardware device that stores decryption keys and makes a determination as to whether it is authorized to send the keys. The hardware device of claim 1 does not send any keys or perform any function that meets the utility requirement of 35 USC 101.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1, 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Ballard US Patent No. 6,847,719.
2. With regards to claim 1, Ballard teaches a hardware device for storing at least one decryption key for use in decrypting an encrypted item of information (Ballard, column 4 lines 7-10, key management module, column 4 lines 31-42), the decryption key being associated with a security code which is used by the hardware device to determine whether it is authorized to send encrypted copies of the decryption key to others (Ballard, column 5 lines 56-60).
3. With regards to claim 6, Ballard teaches the security key being stored within the hardware device (Ballard, column 4 lines 7-10, key management module, column 4 lines 31-42).
4. With regards to claim 12, Ballard teaches the decryption key passed between a plurality of hardware devices (Ballard, column 6 lines 5-14).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2-5, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ballard US Patent No. 6,847,719 in view of Peterson Jr. US Patent No. 5,825,876.

6. With regards to claims 2-3, Ballard teaches the determining if the hardware device is authorized to send a copy of the decryption key to the first entity (Ballard, column 5 line 49 – column 6 line 4), but fails to disclose the encrypting of the decryption key. Peterson teaches the encrypting of the decryption key with the public key of the first entity (Peterson, column 8 lines 22-40). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to utilize Peterson's encryption method with Ballard's key distribution scheme because it offers the advantage of securing communication between the remote terminal and the server (Peterson, column 1 lines 53-67).

7. With regards to claim 4, Ballard as modified teaches that each time the hardware device sends a decryption key to another entity, it modifies the security code associated with the decryption key and sends the modified security code as part of the encrypted decryption key (Ballard, column 5 lines 56-60, column 5 line 49 – column 6 line 4, Peterson, column 8 lines 22-40).

8. With regards to claims 5, 15-17, Ballard as modified teaches the security code being a numeric value indicating the number of times the encryption key can be propagated (Ballard, column 5 lines 56-60). Ballard as modified fails to teach the decrementing of the security code; however, Examiner takes official notice that the decrementing of a code designed to permit an action a specified number of times is well known in the art and at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to decrement the decryption key each time the key is propagated to a further entity because it offers the advantage of providing an simple method of determining if there are any additional propagations to be made.

9. With regards to claim 13, Ballard fails to teach the user's private key being stored within their own hardware device, such that the encrypted decryption key can only be decrypted when the hardware device is in operation. Peterson teaches the user's private key being stored within their own hardware device, such that the encrypted decryption key can only be decrypted when the hardware device is in operation (Peterson, column 9 lines 18-35). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to utilize Peterson's encryption method with Ballard's key distribution scheme because it offers the advantage of securing communication between the remote terminal and the server (Peterson, column 1 lines 53-67).

10. With regards to claim 14, Ballard fails to teach a hardware device including a data processor such that all encryption and decryption of the decryption keys is performed within the hardware device. Peterson teaches a hardware device including a

data processor such that all encryption and decryption of the decryption keys is performed within the hardware device (Peterson, column 9 lines 35-46, column 8 lines 22-40). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to utilize Peterson's encryption method with Ballard's key distribution scheme because it offers the advantage of securing communication between the remote terminal and the server (Peterson, column 1 lines 53-67).

11. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ballard US Patent No. 6,847,719 in view of Laing et al US Patent No. 5,534,857.

12. With regards to claims 7-8, Ballard teaches the accessing of encrypted information (Ballard, column 5 lines 35-48), but fails to teach the hardware device is in the form of a user unit, that a user introduces to a data processor and removes the user unit from the data processor when the user has finished. Laing teaches the hardware device is in the form of a user unit, that a user introduces to a data processor when the user wishes to use the data processor to access encrypted information and removes the user unit from the data processor when the user has finished (Laing, column 4 lines 43-59, user places smart card, key is read from smart card). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to utilize Laing's smart card method with Ballard's key distribution scheme because it offers the advantage of providing a cost effective and competitive manner of ensuring security by using a smart card (Laing, column 2 lines 49-67).

13. With regards to claim 9, Ballard fails to teach that each time the hardware device propagates a decryption key it includes as part of the decryption key an identifier indicating the identity of the sender's key. Laing teaches that each time the hardware device propagates a decryption key; it includes as part of the decryption key an identifier indicating the identity of the sender's key (Laing, column 4 lines 37-42). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to utilize Laing's smart card method with Ballard's key distribution scheme because it offers the advantage of providing a cost effective and competitive manner of ensuring security by using a smart card (Laing, column 2 lines 49-67).

14. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ballard US Patent No. 6,847,719 and Laing et al US Patent No. 5,534,857, as applied to claim 9 above, and in further view of Stanton et al US Patent No. 6,246,771.

15. With regards to claim 10, Ballard as modified fails to teach the decryption key including an audit trail of individuals who have allowed propagation of the key. Stanton teaches the decryption key including an audit trail of individuals who have allowed propagation of the key (Stanton, column 5 lines 5-14, column 6 lines 8-28). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to utilize Stanton's method of creating an audit trail with Ballard as modified because it offers the advantage of providing compliance with export regulations (Stanton, column 5 lines 5-14).

Allowable Subject Matter

Claim 11 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The cited prior art fails to teach or suggest the appending of a control word against their identity in the decryption key to instruct the hardware device to initiate a message to them or an agent of the propagation of the key and giving information concerning that propagation. As such, the cited prior art fails to anticipate or render obvious the above cited claims.

Conclusion

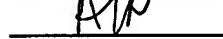
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew L. Nalven whose telephone number is 571 272 3839. The examiner can normally be reached on Monday - Thursday 8-6, Alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on 571 272 3838. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2134

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Andrew Nalven



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